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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/082,844

02/25/2002

Stephen E. Terry

I-2-0160.2US

8107

24374

7590

01/11/2006

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EXAMINER

SHAND, ROBERTA A

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/082,844	Applicant(s) TERRY, STEPHEN E.	
	Examiner Roberta A. Shand	Art Unit 2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/18/05, 5/26/05, 9-12-05</u> | 6) <input type="checkbox"/> Other: _____  |

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

3. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 09/826464.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Applicant broadened claim 11 of parent application 09/826464 producing claim 1 of the present application by eliminating certain elements. Both claims, however claim using a mobile terminal for synchronizing uplink signals in a communication system which supports base station / mobile terminal wireless bi-directional communications via the utilization of a time frame having sequentially identified system time frames, comprising: receiving data from a base station within system time frames including a TA signal which includes TA data and a connection frame number specifying a specific frame for effectuating a timing adjustment; and adjusting the timing

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of uplink transmissions of the mobile terminal in response to the TA data in the received TA signal commencing in the time frame specified in the CFN of the received TA signal.

5. Claim 2 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 09/826464.

Although the conflicting claims are not identical, they are not patentably distinct from each other because Applicant broadened claim 3 of parent application 09/826464 producing claim 2 of the present application by eliminating certain elements. Both claims, however are directed to a mobile terminal which supports base station / mobile terminal wireless bi-directional communications via the utilization of a time frame having sequentially identified system time frames, where base stations transmit selectively formatted communication data to mobile terminals within system time frames comprising: a receiver, a transmitter and an associated processor; to receive data from a base station within system time frames including a TA signal which include TA data and a CFN specifying a frame for effectuating a timing adjustment by selected MT; transmitter to transmit selectively formatted communication data to a base station within system time frames synchronized by the processor; and processor to adjust the timing of the transmissions of the processor in response to the TA data in a received signal commencing in the time frame specified in the CFN.

6. .This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Oksala (U.S. 6477151 B1).

9. Regarding claim 1, Oksala teaches a method (fig. 4 and col. 4, lines 1-29) of using a mobile terminal for synchronizing uplink signals in a communication system which supports base station (BSS) / mobile terminal (MS) wireless bi-directional communications via the utilization of a time frame having sequentially identified system time frames (timing burst), comprising: receiving data from a base station (BSS) within system time frames (timing frames) including a TA (timing advance index) signal which includes TA (timing advance index) data (col. 4, lines 10-17) and a connection frame number (idle frame slot number) specifying a specific frame for effectuating a timing adjustment (col. 4, lines 18-2); and adjusting the timing of uplink transmissions of the mobile terminal in response to the TA (timing advance index) data in the received TA signal commencing in the time frame specified in the CFN (idle frame slot number) of the received TA (timing advance index) signal (col. 4, lines 23-29).

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10. Regarding claim 2, Oksala teaches (fig. 4 and col. 4, lines 1-29) a mobile terminal (MS) which supports base station (BSS) / mobile terminal (MS) wireless bi-directional communications via the utilization of a time frame (timing burst) having sequentially identified system time frames, where base stations transmit selectively formatted communication data to mobile terminals within system time frames comprising: a receiver, a transmitter and an associated processor; to receive data from a base station (BSS) within system time frames (timing burst) including a TA (timing advance index) signal (col. 4, lines 10-17) which include TA data and a CFN specifying a frame for effectuating a timing adjustment by selected MT (MS); transmitter to transmit selectively formatted communication data to a base station (BSS) within system time frames synchronized by the processor (col. 4, lines 18-22); and processor to adjust the timing of the transmissions of the processor in response to the TA (timing advance index) data in a received signal commencing in the time frame specified in the CFN (idle frame slot number) (col. 4, lines 23-29).


### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberta A Shand whose telephone number is 571-272-3161. The examiner can normally be reached on M-F 9:00am-5:30pm.


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12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roberta A Shand  
Examiner  
Art Unit 2665



STEVEN NGUYEN  
PRIMARY EXAMINER